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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

U. S. APPLICATION

SN 10/740,486

Art Unit: 2625

Filed: December 22, 2003

Examiner: Singh

Inventors: Robert A. VANDERHYE

FOR: PRODUCING ARTWORK USING COLOR PRINTERS

* * * * *

June 17, 2008

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REPLY BRIEF

This reply brief is filed to arguments made for the first time in the Examiner's Answer:

REMARKS

The Examiner's Answer misrepresents what was argued by the PTO before in this case, makes up phantom quotes, twists definitions of words beyond any reasonable possibility, and relies on one paragraph of the primary Abram et al reference ("Abram") for things exactly contrary to what it in fact teaches. Everything newly added in the Examiner's Answer supports the conclusion that the PTO made up its mind that it would reject the claims no matter what, and then continues an ever evolving, ever more fantastic, interpretation of Abram to support its pre-determined conclusion.

The Board CANNOT rely on the accuracy of quotes from the references that appear in the Examiner's Answer

Unfortunately, the Board cannot rely on any quotes from the references that appear in the Examiner's Answer because all except one are inaccurate, seemingly having been modified to provide what the Examiner's Answer would like the references to say, rather than what they do say; or sometimes the "quotes" have even been completely fabricated. Appellant has conducted a computer assisted search of the Abram

and Kohno references in the PTO's on-line data base, and has found the following alleged quotes from the Examiner's Answer to be inaccurate or non-existent:

- The first, fourth, and last alleged quotes on page 15
- The second and fifth alleged quotes on page 15 though only because "is" is used instead of "may be"
- All of the alleged quotes on pages 16-21.

Note that some of the alleged quotes add words like "only"¹ which can significantly change the meaning of the quote, and other alleged quotes are simply made up out of whole cloth (such as the quote on page 21). Whether the alleged quotes are fabricated, disingenuous, or simply imprecise, they indicate that the PTO is only interested in justifying its already determined conclusion that the claims are unpatentable, rather than intelligently evaluating the claims with respect to the real prior art.

Paragraph [0028] of Abram is contrary to the invention

Contrary to the statement at the middle of page 3 of the Examiner's Answer "For completeness, the rejection as set forth in the Final Office Action, mailed December 27, 2007, is duplicated below," what follows that statement has little resemblance to the Final, as even a cursory inspection reveals. Most significantly, the rejection first paragraph now refers three separate times to paragraph [0028] of Abram – a part of Abram NEVER referred to previously in either the Final or the Advisory Action. The first paragraph of the rejection now also mentions for the first of sixteen times in the Examiner's Answer a novel interpretation of the word "disable" that is ostensibly supported by paragraph [0028].

Since paragraph [0028] of Abram was never even mentioned before in the entire extensive prosecution of this application, and now is the cornerstone of the entire rejection, being referred to no less than nineteen times, appellant reproduces that paragraph below:

"[0028] In any embodiment described above, color samples may be generated from the digital image and a fixed or programmable palette of colors may be assigned to image areas of the coloring book image. Further, an index number may be assigned to a corresponding sample color and the index number and color

¹ Which *per se* nowhere appears in Abram, except twice as part of "read only memory"

may be printed with the coloring book image to produce a color-by-numbers coloring book image. The coloring book images generated in any of the embodiments described above may be combined with stock line-art images to generate a storyboard. The storyboard may be printed in the form of a coloring book.” [emphasis added]

As this portion of Abram makes abundantly clear, no colors corresponding to the digital image colors are printed at all. Rather, “...an index number may be assigned to a corresponding sample color and the index number and color may be printed with the coloring book image to produce a color-by-numbers coloring book image”. That is, a small sample of an “assigned” color, along with an index number assigned to that color, are printed so as to guide the user in a classic “color-by-numbers” coloring book.

The procedure of Abram should be contrasted with the procedure of the claimed invention. According to the invention a multicolor digital image is input into or selected from a computer. The multicolor image is not changed in any way. There is no “sample” “generated” from the digital image, no color “assigned” to various portions of the image, no “index number” assigned, nor any sampling thereof whatsoever. According to the invention one or some, but not all, of the actual colors of the multicolor digital image are disabled, and the non-disabled colors printed onto a substrate. The entirety of the colors are printed without change; there is no mere “sample” printed, nor is the color changed by “assigning” a sample color and index number to it. What one ends up with is NOT a classic “color-by-numbers coloring book image”, but after the addition of artistic elements, an artwork. Compare Figures 9 and 21 of the instant application with Figure 8 of Abram. [Note there is no representation in any drawing of Abram of the sample color or index number].

Of course it is absolutely clear that paragraph [0028] does not teach the claimed invention. This is why it was never mentioned in the Final or Advisory Action. It is mentioned now only after the relevance of all other portions of Abram previously referenced in the Final and Advisory Action were destroyed!

In fact, paragraph [0028] provides a teaching exactly contrary to the claimed invention since it teaches one “assigns” other colors and index numbers to “image areas of the coloring book image”, and then never prints anything but “samples” of the

assigned colors, along with the index numbers, when providing a color-by-numbers book. Where a teaching of a reference is specifically contrary to a claimed invention, there can be no obviousness. *KSR v Teleflex Inc.*, 550 U. S. 1, 127 S. Ct. 1727, 1739-40 (2007); *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed Cir 1986).

The term “disable” in its various forms is grossly misinterpreted

What the Examiner’s Answer does next – after referencing paragraph [0028] – is to read the claim term “disable” in its various forms in such a manner as to do complete violence to it, rather than giving it its normal reasonable interpretation.

The verb “disable”, as used according to its normal meaning in several difference forms in the claims (for example limitations b) and c) of claim 1) means to “make unable to perform a certain action; ‘disable this command on your computer’”². That is a function or action it would otherwise normally perform is rendered inoperative. Limitations c) from claims 1 and 24 also specifically call for printing the “non-disabled color or colors”, while limitation c) in claim 20 calls for “printing a substantially accurate representation of the image, but without about 80-100% of the black and near black”, the later having been “disabled” in limitation b) of claim 20.

The Examiner’s Answer says – sixteen times – “it is being interpreted by the examiner that only those colors included in the palette of colors is printed and the other colors are disabled”. This is a grossly erroneous interpretation of “disabled”. Abram, in [0028], doesn’t “make unable to perform a certain action” anything. What Abram does is “assign” a “sample” color and index number to various image areas of the coloring book, and then print the “sample” color and index number to make a “color-by-numbers” coloring book. Abram changes all of the colors of the digital image by assigning them new colors from a palette of colors, and then printing only samples of the assigned colors.

Abram certainly NEVER prints “a substantially accurate representation of the image, but without about 80-100% of the black and near black” as recited in c) of claim 20, because Abram never prints “a substantially accurate representation” of any part of the digital image, only samples of assigned colors. Abram also certainly NEVER prints

² From WordNet 3.0, 2006, Princeton University.

“the non-disabled color or colors of the image” as recited in c) of each of claims 1 and 24 because – again – Abram prints only samples of assigned colors.

The claim terms are to be given their broadest reasonable interpretation consistent with the specification, with the emphasis on the word “reasonable”. *In re Royka*, 180 USPQ 580, 582-3 (CCPA 1974)³. Here, there is nothing “reasonable” about interpreting the limitation “non-disabled [pre-existing image] colors” (bracketed material added) to mean “mere samples of assigned [not pre-existing] colors”, or to interpret “disabled” to mean “un-chosen assigned color samples”. Since the interpretation of these terms in the Examiner’s Answer is unreasonable, it cannot be used.

The Examiner’s Answer consistently makes inappropriate inherency assumptions

The entire Examiner’s Answer manufactures mere possibilities in Abram that are gleaned from knowledge of the invention into inherent features, including in the inaccurate “quotes” identified above. However, inherency requires that the missing descriptive material be “‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir.1999)). Therefore the approach in the Examiner’s Answer is unacceptable.

The Examiner’s Answer consistently ignores limitations

On numerous occasions, the Examiner’s Answer does not even make even a token attempt to show where a limitation might be found in Abram, or why it is obvious over Abram, or simply misrepresents something exists in Abram when it does not. Perhaps the two clearest examples are the “near black” and the “at least thirty pound matte paper” limitations.

–“Near black” is called for in claims 9, 14, 15, 20-22, and 25. This term is one that appellant believes he has coined, and is discussed on page 11, 3rd and 4th full paragraphs, of the specification. Only by disabling both black and near black could the image of Figure 20 be turned into that of Figure 21, or the image of Figure 8 be turned

³ Applied in *In re Schmidt*, 892 F. 2d 1051 (Fed Cir 1989) in reversing a rejection where the interpretation of one term was unreasonable, even inconsistent with the specification.

into that of Figure 9. The Examiner's Answer – e. g. on pages 10 and 17-19 – doesn't even attempt to address “near black”, but rather simply uses the word “black”. Disabling only black is ineffective according to the invention; BOTH black and near black must be disabled. Thus the Examiner's Answer is completely deficient.

–“At least thirty pound matte paper” is recited in claim 22. It is alleged at the bottom of page 11 of the Examiner's Answer that this is shown in “Fig. 9, S925” and “paragraph [0040]” of Abram. That is incorrect. There is no disclosure of “matte” paper anywhere in Abram, let alone in those sections; that is the word “matte” is non-existent in Abram. The claim limitation has simply been ignored, despite the fact that at least 30 pound matte paper has been determined according to the invention to be a highly desirable substrate.

The other ignored limitations are fully discussed in the appeal Brief, and nothing in the Examiner's Answer changes what is there.

The Examiner's Answer refuses to believe a new use of an old machine is patentable

Regarding the rejection of claim 11, the Final, Advisory Action, and now the Examiner's Answer, refuse to recognize a basic aspect of U. S. Patent Law. A new use of an old machine is patentable, when the new use is presented in method/process claims. This is codified in 35 U. S. C. §100(b), and clear from *In re Dillon*, 892 F. 2d 1554, 1569 (Fed Cir 1989). Here there is NO place in Kohno where there is any suggestion whatsoever of printing with the black ink cartridge removed. The alleged quote from col. 5, lines 43-59 of Kohno on page 21 of the Examiner's Answer is fabricated. The quote DOES NOT appear anywhere in Kohno, let alone in col. 5, lines 43-59. Not even the phrases “attached or removed” or “purpose of the printing” appear anywhere in Kohno. However, even if the words did appear in Kohno, they don't teach the invention.

The mere fact that the black cartridge of Kohno can be removed means nothing. There being no suggestion to, or reason for, removing the black ink cartridge during printing, Kohno cannot render obvious claim 22, a new use of an old machine claim.

Conclusion

Everything else is fully discussed in the Appeal Brief, and nothing in the Examiner's Answer changes the discussion in the Appeal Brief. Therefore, early reversal of the final rejection and passage to issue are earnestly solicited.

Respectfully Submitted,



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